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Mailed: September 29, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re 41 Saxon Avenue Corp.

Serial No. 76425929

Edwin D. Schindler, Esq. and Michael I. Kroll, Esq. for 41 Saxon Avenue Corp.

J. Brendan Regan, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Quinn, Walters and Rogers, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

41 Saxon Avenue Corp. has filed an application to register the mark SC LABORATORIES on the Principal Register for, as amended, "industrial and scientific equipment, namely, transducers that utilize oscillations to test for stress and fatigue in metal and metal structures; measuring devices, namely, folding and graduated rulers, tape measures and acoustic equipment for measuring feedback; weighing devices, namely, scales for laboratory use; and detecting devices, namely, sonic evaluation devices for evaluating

level of quackiness of music," in International Class 9, and "music and audio accessories, namely guitar audio picks," in International Class 15.¹ Applicant entered a disclaimer of LABORATORIES apart from the mark as a whole.

The Trademark Examining Attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), as to applicant's goods in International Class 15 only, on the ground that applicant's mark so resembles the mark SC, previously registered for musical instruments, namely, guitars and bass guitars,² that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the examining attorney have filed briefs, but an oral hearing was not requested.

The examining attorney contends that SC is an arbitrary term; and that the marks create the same overall commercial impression because applicant's mark consists of the registered mark SC in its entirety, with the addition of the merely descriptive, and disclaimed word LABORATORIES. The

¹ Serial No. 76425929, filed June 26, 2002, based on an allegation of a bona fide intention to use the mark in commerce. Although the Examining Attorney issued a final refusal requiring a further amendment to the identification of goods, applicant, in its brief, indicated that the issue was under discussion with the Examining Attorney, who did not pursue this ground for refusal in his brief. Therefore, we consider the refusal based on the identification of goods to be withdrawn and we have given it no consideration.

examining attorney submitted an excerpt from applicant's web site showing applicant's proposed mark appearing directly below a larger and stylized "SC" in support of his contention that SC is the dominant portion of applicant's mark.

Regarding the goods, the examining attorney asserts that applicant's guitar picks and registrant's guitars are "highly related" products, noting that "[i]t is axiomatic that 'guitar audio picks' have a symbiotic relationship with 'guitars and bass guitars.'" (Brief, p. 5.) In support of his position, the examining attorney submitted a list and copies of numerous third-party registrations wherein each registered mark includes both guitars and guitar picks in the identification of goods.

Applicant contends that the examining attorney has dissected the mark; that the LABORATORIES portion of its mark is as significant as the SC portion of its mark; and that the LABORATORIES portion of its mark adequately distinguishes it from the registered mark. Applicant presents no argument in its brief regarding the relationship, or lack thereof, between its goods in International Class 15 and the goods listed in the cited registration.

² Registration No. 1304956 issued November 13, 1984, to Leo C. Fender, in International Class 15. [Sections 8 and 15 affidavits accepted and acknowledged, respectively.]

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein. The factors deemed pertinent in this proceeding are discussed below.

We consider, first, the goods involved in this case, and we note that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See

also, Octocom Systems, Inc. v. Houston Computer Services, Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. The question is not whether purchasers can differentiate the goods themselves but rather whether purchasers are likely to confuse the source of the goods. *See Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). It is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each party's goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

There is no question that guitars and guitar picks are complementary products since the sole use of a guitar pick is to pluck the strings of a guitar. We take judicial notice of the definition in *Merriam Webster's Collegiate Dictionary* (11th ed. 2003) of "pick" as, *inter alia*, "a

small thin piece (as of plastic or metal) used to pluck the strings of a stringed instrument" and of "guitar" as "a flat-bodied stringed instrument with a long fretted neck and usually six strings played with a pick or with the fingers." Additionally, while the third-party registrations submitted by the examining attorney, which cover various goods and/or services and which are based on use in commerce, are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, such registrations nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988). We find on this record that the respective goods are closely related.

We consider next whether applicant's mark, SC LABORATORIES, and the registered mark, SC, when viewed in their entirety, are similar in terms of appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to

result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entirety, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Applicant correctly notes that its mark should be considered as a whole and that the mere fact that the word LABORATORIES is disclaimed does not remove it from the mark. However, we agree with the examining attorney that SC is the dominant portion of applicant's mark. Not only is SC the first term in the mark, but the term LABORATORIES is likely to be perceived as merely indicating the type of company from which the products come. Therefore, we find that applicant's mark, SC LABORATORIES, is substantially similar to the registered mark, SC, in overall commercial impression.

In conclusion, we find that in view of the substantial similarity in the commercial impressions of applicant's mark, SC LABORATORIES, and registrant's mark, SC, their

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contemporaneous use on the closely related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods].

Decision: The refusal under Section 2(d) of the Act with regard to the goods in International Class 15 only is affirmed. In due course, the application will proceed to publication in International Class 9 only.